

REMARKS

Claims 1-52 are pending in the present application and are subject to a restriction requirement.

COMMENTS ON RELATED APPLICATION

Before turning to the restriction and election of species requirements, Applicants take this opportunity to note that the present application is the United States National Phase Application of PCT/US2005/005815 which published on September 22, 2005, as WO 2005/086661. An analogous application was also directly filed in the United States Patent and Trademark Office. This analogous application is U.S.S.N. 11/067,377 which published on January 5, 2006, as US 2006/0004012. US 2006/0004012 was listed on a modified form PTO-1449 that was previously submitted with respect to the present application. A notice of allowance was received with respect to U.S.S.N. 11/067,377, and the issue fee was recently paid.

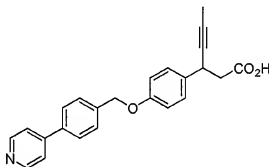
RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

The Office Action imposes a restriction requirement under 35 U.S.C. § 121 between the claims of Groups I, II, III, IV, and V. The Office Action defines Groups I-V as set forth below:

- I. Claims 1-40, drawn to a chemical compound and a pharmaceutical composition of formula I.
- II. Claims 41, 42, and 45-47, drawn to a method of treating a disease or condition using a chemical compound of formula I.
- III. Claims 43-45, drawn to a method for treating a disease or condition response to the modulation of GPR40 using a chemical compound of formula I.
- IV. Claims 48 and 49, drawn to a method for modulating GPR40 function in a cell using a chemical compound of formula I.
- V. Claims 50-52, drawn to a method for modulating circulating insulin concentration in a subject using a chemical compound of formula I.

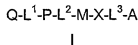
In response to the restriction requirement, Applicants hereby provisionally elect the claims, compounds, and compositions of Group I (claims 1-40) for prosecution without traverse.

In addition to the restriction requirement noted above, the Office Action requires that Applicants elect a single compound to begin examination. In compliance with the Office Action, Applicants elect the following compound (Example 10.13, Table 21 page 137 of the published PCT application (WO 2005/086661)) to begin prosecution:



Example 10.13.

As recited in independent claim 1, the compound of formula I has the following structure:



In the compound elected to begin examination and shown above (Example 10.13), the variables in the compound of formula I have the following definitions:

Q is a heteroaryl group (a pyridyl group);

L¹ is a bond;

P is an aromatic ring (a benzene);

L² is an oxymethylene or a (C₂-C₆)heteroalkylene (a -CH₂O-);

M is an aromatic ring (a benzene);

X is CR³R⁴;

R³ is a (C₂-C₈)alkynyl or a (C₃-C₈)alkynyl (a -C≡C-CH₃);

R⁴ is a H;

L³ is a (C₁-C₅) alkylene (a CH₂); and

A is -CO₂H.

Example 10.13 is encompassed by claim 1 and each of dependent claims 2-32, and 34-39. This compound would also be encompassed by compositions including the compound as recited by claim 40. Because each of the method claims depends directly from independent claim 1 or another method claim that depends from claim 1, a method using Example 10.13 in accordance with the methods could also be encompassed by a method using the compound.

Although Applicants do not formally traverse the election of species requirement, Applicants respectfully direct the Examiner's attention to § 803.02 of the MPEP which describes restriction practice when Markush groups are present in a claim. As stated in this section of the MPEP,

Since the decision in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Hamish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ.2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.
(Emphasis added)

Therefore, Applicants respectfully request that no further restriction of claim 1 be required based on the species elected to begin examination. As noted in § 803.02, **a Markush type claim may even include independent and distinct inventions.** As explained in § 803.02 of the MPEP, an examiner may require a provisional election of a single disclosed species prior to examination on the merits as required in the present Office Action. However, as further explained in §803.02 of the MPEP, further restriction to the elected species is only appropriate if the Markush-type claim is found to not be allowable over the prior art.

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species withdrawn from further consideration.
(Emphasis added)

As further explained in the following excerpt from §803.02 of the MPEP,

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *nonelected* species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final.

(Emphasis added)

Obviously, should no prior art be found during the extended search required by §803.02, then each of the claims of Group I should be allowed without further restriction.

CONCLUSION

The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes such would be helpful in advancing the application to issuance.

Respectfully submitted,

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